



07 JUL 2008

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In re Application of :
MARTIN *et al* :
Application No.: 10/530,695 :
PCT No.: PCT/GB2003/004499 :
Int. Filing Date: 13 October 2003 :
Priority Date: 11 October 2002 :
Docket No.: 2088.001400/14.0223 :
For: METHOD AND APPARATUS FOR :
POSITIONING OF SEISMIC :
CABLES :

DECISION

This is a decision on the papers filed 27 February 2008 which are treated as a renewed petition under 37 CFR 1.47(a).

BACKGROUND

On 27 December 2007, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants were given two months to respond.

On 27 February 2008, applicants filed the subject response.

DISCUSSION

Applicants claim that co-inventor Kyrre Tjoems refuses to cooperate.

As previously indicated, a petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

The petition fee of \$200.00 has been paid. Item (1) of 37 CFR 1.47(a) is complete.

The last known address of the nonsigning inventor was provided as Schlumberger House, Solbraaveien 23, N-1370 Asker, Norway. Item 3 of 37 CFR 1.47(a) is satisfied.

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Regarding item (4) of 37 CFR 1.47(a), applicants submitted a declaration signed by three of the four named inventors with the original petition on 13 February 2006. The prior decision noted that the name of the nonsigning inventor is recorded as THOM, Kyrre on the international publication (WO/2004/034091) and listed as TJOEM, Kyrre on the declaration. Counsel did not provide an explanation regarding the name change in the original petition.

In the renewed petition, counsel indicates that the differences in spelling of the inventor's name is a result of a transliteration difference. This is an adequate explanation. No petition is required. See § 201.03 MPEP.

A review of the declaration filed 13 February 2006 indicates that it complies with 37 CFR 1.497(a) and (b) and meets the requirements of section 409.03(a)(A) of the MPEP. Item (4) of 37 CFR 1.47(a) is complete.

Regarding item (2), petitioner's burden in showing that an inventor refuses to cooperate is explained in section 409.03(d) of the MPEP. Several pertinent segments are listed below:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made . . .

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient . . .

If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

Here, the 37 CFR 1.47(a) applicants have not shown that a complete copy of the present U.S. national stage application, including specification, claims and drawings, was sent to, and received by the nonsigning inventor.

The original petition filed 13 February 2006 included a statement by Ms. Rebecca Tanis who indicated that she sent an email request to the personal account of the nonsigning inventor on 20 December 2005 requesting that he sign a declaration for docket No. 14.0223PCT-US. No response was received from Mr. Tjoems. Ms. Tanis then stated that she "sent another request together with the patent application via Federal Express" which was delivered on 06 February 2006 according to Federal Express. No response was received.

The statement by Ms. Stanis does not indicate that a complete copy of the subject application was presented to the nonsigning inventor on 20 December 2005. (assuming that docket No. 14.0223PCT-US referenced by Ms. Tanis is the same as the subject application which is listed as docket No. 2088.001400/14.02230). A copy of the 20 December 2005 email was not included with the original petition. As such, no refusal can be inferred from the conduct of Mr. Tjoem.

Ms. Tanis then states that documents including a copy of the 'patent application' was delivered to the nonsigning inventor on 06 February 2006 by Federal Express. However, petitioners did not provide any documentary evidence to support this claim. Petitioners must submit a copy of the 06 February 2006 cover letter sent to the nonsigning inventor and copies of the Federal Express delivery documents showing that delivery of these papers was made to Mr. Tjoems.

Moreover, the documents were purportedly delivered to the nonsigning inventor on 06 February 2006 in Norway. The petition was filed in Houston, Texas on 13 February 2006. Even if Mr. Tjoems had responded in a timely manner by mail, it is unlikely that the documents would have been received by petitioners before filing this petition.

In the renewed petition, the 37 CFR 1.47(a) applicants did not provide any additional documentary evidence showing that a complete copy of the subject application was received by the nonsigning inventor. The 37 CFR 1.47(a) applicants discussed that Mr. Tjoems has refused to join a patent application in a separate case. Petitioners assert that is evidence that there exists "a rupture in the employer/employee relationship" between the assignee and the assignees.

That may indeed be the case; nonetheless, petitioners must still show that a complete copy of the subject application was presented (or attempted to be presented) to Mr. Tjoems in the above-captioned application, for a refusal to cooperate to be granted. For this reason, item (2) of 37 CFR 1.47(a) is not yet satisfied.

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CONCLUSION

For the reason discussed above, applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available.

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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